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#4

In re Application of
Shinji KAMEI
Application No.: 08/973,564
PCT No.: PCT/JP96/01622
Int. Filing Date: 13 June 1996
Priority Date: 16 June 1995
Attorney's Docket No.: 31425PCT/USA
For: SEMICONDUCTOR DEVICE, IC CARD
UTILIZING SAME AND COMMUNICATION
SYSTEM

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DECISION ON
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PETITION
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UNDER 37 CFR 1.47(b)
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This decision is in response to petitioner's petition under 37 CFR 1.47(b) filed 03 March 1998 that seeks the acceptance of the application without the signature of the inventor Shinji Kamei. The fee of \$130 under 37 CFR 1.17(i) for this petition will be charged to deposit account 02-4377, as authorized in the petition.

BACKGROUND

On 13 June 1996, applicant filed international application PCT/JP96/01622, which claimed a priority date of 16 June 1995. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 January 1997. A copy of the international application was communicated to the United States Patent and Trademark Office on 12 June 1997. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 December 1997.

On 05 December 1997, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and multiple dependent claim fees.

On 03 March 1998, before receiving a Notification Of Missing Requirements (Form PCT/DO/EO/905), applicant filed the instant petition under 37 CFR 1.47(b) accompanied by, *inter alia*, a declaration executed by an official of Rohm Co., Ltd. on behalf of the non-

signing inventor; the requisite surcharge under 37 CFR 1.492(e); a statement under 37 CFR 3.73(b); copies of assignments to Rohm Co., Ltd.; a statement of proprietary interest of Rohm Co., Ltd. signed by Koji Takahashi; an official of Rohm Co., Ltd.; a statement of proof of need to prevent irreparable damage; and a statement of facts describing efforts to obtain the signature of the non-signing inventor by Haruo Hagimori.

On 16 March 1998, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and surcharge under 37 CFR 1.492(e) were required within one month from the date of the notification.

On 15 April 1998, in response to the Form PCT/DO/EO/905 applicant filed a "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" accompanied by a copy of the papers filed 03 March 1998 and post card receipt.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Applicant has satisfied items (1) and (3) - (6) above, but has not satisfied item (2).

Regarding item (1) above, as authorized on page 3 of the transmittal letter filed with the instant petition, the \$130 fee under 37 CFR 1.17(i) will be charged to **deposit account 02-4377**. Regarding items (3) and (4) above, the declaration is signed by an official of the alleged assignee on behalf of the non-signing inventor and states the last known address of the non-signing inventor. As to item (5), applicant has submitted a statement under 37 CFR 3.73(b) accompanied by copies of assignments to Rohm Co., Ltd. The statement that the instant national stage application papers had to be submitted by 16 December 1997 and a declaration timely submitted in order to claim the priority date of 16 June 1995 is sufficient to satisfy item (6) above.

Regarding item (2), before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the

non-signing inventor's attorney. MPEP 409.03(d). In the instant case, neither the declaration of facts by Haruo Hagimori nor the accompanying letters clearly state that petitioner presented a copy of the application papers (specification, including claims, and any drawings) to the non-signing inventor.


Accordingly, it would not be appropriate to grant the petition under 37 CFR 1.47 at this time.


CONCLUSION

For all of the reasons discussed above, the petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 executed by the inventor or correct the defects noted above within a time period of **TWO (2) MONTHS** from the mail date of this decision. **THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


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